



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,533	10/11/2001	Corey J. Norris	10011776-1	1510

7590 02/12/2003

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER	
BUCHANAN, CHRISTOPHER R	
ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,533

Applicant(s)

NORRIS, COREY J.

Examiner

Christopher R Buchanan

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka et al. alone.

With regard to claim 1, Otsuka discloses a method for transferring an electronic document to print media in exchange for payment (see abstract) that includes discovering payment account information (30, 31, Fig. 5, col. 7 line 1+), accepting an electronic document (S2, Fig. 7A), transferring the electronic document to print media (col. 14 line 21+), determining a price for the service (col. 16 line 40+, inherent in the invention), and executing a payment transaction at the determined price (col. 16 line 40+, S4, Fig. 7A). With regard to claims 2 and 3, discovering the payment account information includes reading information from an encoded strip (col. 7 line 5+, common practice with credit cards) or receiving a transmission with payment information (see Fig. 5, common practice). With regard to claim 4, accepting the electronic document includes receiving a transmission including the document (S5, Fig. 7A, col. 8 line 1+). With regard to claim 5, it would be obvious to one skilled in the art to charge a fee that is based on the number of pages printed, since this is common practice in the art (printing

Art Unit: 3627

shops). With regard to claim 6, payment account information is verified (col. 6 line 61+).

With regard to claim 7, after the payment account information is received the document is printed (see Fig. 7A).

3. Claims 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka et al. alone.

With regard to claim 8, Otsuka discloses an output apparatus (1, Figs. 1 and 4) for transferring an electronic document to print media in exchange for payment (see abstract) that includes a point of service terminal for discovering payment account information (30, 31, Fig. 5, col. 7 line 1+), a communication interface (3) for accepting an electronic document (S2, Fig. 7A), a transcriber for transferring the electronic document to print media (col. 14 line 21+), a tabulator for determining a price for the service (col. 16 line 40+, inherent in the invention), and an invoicer for executing a payment transaction at the determined price (col. 16 line 40+, S4, Fig. 7A). With regard to claims 9 and 10, discovering the payment account information includes reading information from an encoded strip with a strip reader (col. 7 line 5+, common practice with credit cards) or receiving a transmission with payment information (see Fig. 5, common practice). With regard to claim 11, accepting the electronic document includes receiving a transmission including the document (S5, Fig. 7A, col. 8 line 1+). With regard to claim 12, it would be obvious to one skilled in the art to charge a fee that is based on the number of pages printed, since this is common practice in the art (printing shops). With regard to claim 13, payment account information is verified (col. 6 line

Art Unit: 3627

61+). With regard to claim 14, after the payment account information is received the document is printed (see Fig. 7A).

4. Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka et al. alone.

With regard to claim 15, Otsuka discloses a program storage system (1, Fig. 5) embodying a program executable by a computer (20) to perform the steps of a method for transferring an electronic document to print media in exchange for payment (see abstract) the steps including discovering payment account information (30, 31, Fig. 5, col. 7 line 1+), accepting an electronic document (S2, Fig. 7A), transferring the electronic document to print media (col. 14 line 21+), determining a price for the service (col. 16 line 40+, inherent in the invention), and executing a payment transaction at the determined price (col. 16 line 40+, S4, Fig. 7A). With regard to claims 16 and 17, discovering the payment account information includes reading information from an encoded strip (col. 7 line 5+, common practice with credit cards) or receiving a transmission with payment information (see Fig. 5, common practice). With regard to claim 18, accepting the electronic document includes receiving a transmission including the document (S5, Fig. 7A, col. 8 line 1+). With regard to claim 19, payment account information is verified (col. 6 line 61+). With regard to claim 20, after the payment account information is received the document is printed (see Fig. 7A).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Akel et al. disclose a system wherein an electronic document is transmitted to a local terminal and printed. Deaton et al. disclose a system that provides customers at a remote point of sale with purchase incentives via a network. Walker et al. disclose a system that allows a user to print traveler's checks at a remote terminal via a computer network. Safai et al. disclose a system that allows users to transport digital images over a network and print them at a central location for a charge.

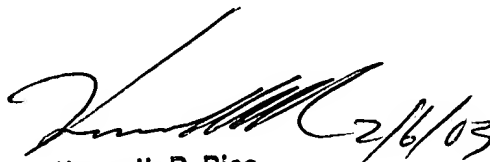
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R Buchanan whose telephone number is 703-306-5782. The examiner can normally be reached on M-T 9-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

CRB

Christopher Buchanan
January 29, 2003


Kenneth R. Rice
Primary Examiner